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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,509	08/24/2001	Gregory P. Campau	1-23339	2340

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MACMILLAN, SOBANSKI & TODD, LLC  
ONE MARITIME PLAZA - FOURTH FLOOR  
720 WATER STREET  
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EXAMINER

SCHWARTZ, CHRISTOPHER P

ART UNIT                      PAPER NUMBER

3683

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No. 09/939,509	Applicant(s) CAMPAU ET AL.
Examiner Christopher P. Schwartz	Art Unit 3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on \_\_\_\_.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-40 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) 1-20 and 26-35 is/are allowed.
- 6)  Claim(s) 21-25 and 36-40 is/are rejected.
- 7)  Claim(s) \_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_

CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER  
*[Signature]*

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## DETAILED ACTION

### *Reissue Applications*

1. On the paper titled "assent by assignee for filing of reissue application" the person who signed this submission, Mariann McNally, has failed to state her capacity to sign for the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP ' 324.

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the assignee. 37 CFR 3.73(b).

A proper submission establishing ownership interest in the patent, pursuant to 37 CFR 1.172(a), is required in response to this action.

2. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

3. Claims 21-25,36-40 remain rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments, Inc.*, 59 USPQ 2d 1597 (Fed. Cir. 2001); *Ex parte Yamaguchi*, 61 USPQ2d 1043 (Bd. Pat.

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App. & Inter. 2001)(reported but unpublished, precedential), and *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003; *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The cases outlined above provide a guide for determining whether a claim presented in a reissue application is subject to recapture. Applicant's have referenced the USPTO Memorandum dated August 4, 2003 discussing the cases cited above in their remarks on pages 16-17. The Memorandum was sent by the examiner to applicant's to assist them in preparing their response to the previous Office action.

As applicant's have correctly pointed out the test for recapture of previously surrendered subject matter is now a 3 step process, as outlined by the Court in the *Pannu* decision: The first step (1) is to determine whether, and in what aspect(s), the reissue claims are broader than the patent claims. The second (2) step is to determine whether the broader aspects of the reissued claims relate to surrendered subject

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matter. The third step (3) determines whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

As stated in the Memorandum at page 2 when analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application, so that it becomes narrower. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. Second, it must be determined whether the reissue claim entirely omits any limitation that was added or argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture (*see Pannu*).

The Board in *Yamaguchi* held that only an applicant's statement, argument, or amendment (or consent to an examiner's amendment by the applicant) can establish a surrender of claimed subject matter on which to base recapture.

The *Pannu* decision provides a clear statement that recapture is not always avoided by making a reissue claim narrower than the claim subject matter "canceled" from the original application in favor of more specific claim subject matter, in order to overcome an art rejection. The *Pannu* court decided that a limitation A which was added in an original application to overcome an art rejection cannot then be omitted in a

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reissue application and replaced by a different narrowing limitation, B which is not related to limitation A. As a result of *Pannu*, the Memorandum concluded the following:

A. Given:

- 1) A claim limitation is presented/argued/stated in an original application to make the claims allowable over an art rejection made in the original application, and
- 2) The claim limitation is then omitted, in its entirety, in the reissue application claims.

Then:

The omitted limitation relates to subject matter previously surrendered by applicant, impermissible recapture of the surrendered subject matter exists, and the reissue application claims should be rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the reissue application is based.

B. If the omitted limitation is replaced by another limitation that is not related to the subject matter previously surrendered by applicant, recapture exists, even though the replacement limitation is a material (narrowing) limitation, and even where the replacement limitation defines the claims over the prior art. See *Clement*.

C. If the omitted limitation is replaced by another limitation that is related to the subject matter previously surrendered by applicant, recapture has been avoided. The replacement limitation certainly can be more specific than the omitted limitation. In addition, the *Eggert* decision held that the related replacement limitation can be broader

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than the omitted limitation, as long as the replacement limitation provides a claim that is narrower than the canceled claim subject matter, i.e., narrower than the subject matter "canceled" from the original application (in favor of more specific claim subject matter) in order to overcome an art rejection. The principles outlined above are further discussed by way of examples in the Memorandum.

The analysis above is predominantly concerned with a comparison of the subject matter of the independent claims in the reissue and parent applications.

Therefore, in light of the analysis above, the independent claims in the patent required a fluid separator (see line 9 of claim 1). Specifically, an argument was made by applicants in paper number 10 on the last paragraph of page 15 of the original file wrapper to establish patentability over the Steiner '713 patent-- Steiner et al. Do not teach or suggest alone or in combination with the references of record, at least the underlined structure recited in claim 1 (i.e. fluid separator and add limitation of the movable pressure boundary). Applicant's repeated claim 1 in it's entirety in their arguments. On page 16 line 1 applicants state "Claim 8 has been amended to recite that the pedal simulator recited therein is connected via a fluid conduit to the master cylinder recited therein; and further that the expansion volume unit is in fluid communication with master cylinder and the pedal simulator via that fluid conduit." Page 16 line 11 applicant's further made an argument with respect to independent claim 8 "Steiner et al. do not teach or suggest, alone or in combination with other cited references, that the reservoir 41 is in fluid communication with the master cylinder 13 and the reservoir 42 via the fluid conduit connecting the master cylinder 13 and the reservoir

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42, [ ] the fluid conduit 36". Applicant's made similar arguments with respect to the damping circuit with respect to patent claim 3 (see page 17 lines 3-4 and the repetition of claim 3) and limitations directed to the blending of the pressure signals from the brake pressure sensors 76,77 with a pedal position signal (pages 18 and top of 19).

Therefore, because the limitations of the amended claims in the patent, which are germane to the prior art of record as substantiated by applicant's arguments, are not found in at least substantially the same form in any of the independent claims submitted in the reissue application, they remain rejected under the recapture doctrine, as outlined above. See the three principles stated in Pannu.

***Claim Rejections - 35 USC ' 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 21 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Burgdorf.

Regarding claim 21, subject to the 112 above, Burgdorf in figure 2 discloses a brake system adapted for an axle of a vehicle comprising a normal source of pressurized hydraulic brake fluid (37 or 47) and a backup source of brake fluid 54. Note the first and second fluid conduits going to each of the wheel brakes 30,31 or 32,33.



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6. Claims 21,23-25 rejected under 35 U.S.C. 102(b) as being anticipated by Shirai '777.

Regarding claims 21 and 23 note the independent sources for generating braking pressure at 12 and 112, the first and second brake circuits 16,20 or 18,22 leading to the wheel brakes and the valves at 44 and 46 which may be selector switch operated at 58 and are also subject to control by control device 120 dependent upon a signal from pedal switch 130. Although shown closed in the figure, it is presumed this illustration shows only one of three "normal" positions. See the bottom of col 5 and top of col 6 and the bottom of col. 9 and top of col. 10. Note the first brake system sensor at 132

7. Claims 21-25,36-40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Steiner.

Regarding claims 21-25 Steiner meets the claimed requirements as broadly claimed. The normal hydraulic energy source is shown at 77, the "first system sensor that is actuated by a brake pedal" as broadly claimed, may be one of the ABS sensors discussed at the bottom of col. 5 or at 72,76. Note the operation of the normally open valves 48,49 as discussed at the bottom of column 3 and the fluid separator devices at 24 and/or 26. As broadly claimed by applicant the "back up" source to an ABS/TRC operation could in fact be the master cylinder should the pump fail. Note the fluid conduits coming off of the master cylinder which can be interpreted as the first and second backup conduits.

8. Claims 36,38,40 are rejected under 35 U.S.C. 102(b) as being anticipated by Winner et al. '718..

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Regarding claims 36,38 and 40 Winner et al. discloses in col. 4 and figure 1 a normal source of pressurized brake fluid 25, a backup source 6, first and second backup fluid conduits, 12,13 and valve arrangements 54,55 or 70 disposed in the first and second backup conduits between the master cylinder and wheel brakes, and capable of functioning in the claimed manner.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 37 rejected under 35 U.S.C. 103(a) as being unpatentable over Winner et al. in view of Steiner

Regarding claim 37, as explained above, Winner et al. discloses all of the features required but lacks a showing of the fluid separator units as claimed.

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However such pressure modulators or "fluid separator units", as broadly claimed, are notoriously well known in the art as taught by Steiner at 24,26.

One having ordinary skill in the art at the time of the invention would have found it obvious to have provided the device of Winner et al. with such fluid separator units, as taught by Steiner to adjust the pressures output to the wheel brakes..

***Allowable Subject Matter***

12. Claims 1-20,26-35 are allowed.

***Response to Arguments***

13. Applicant's arguments filed 11/24/03 have been fully considered but they are not persuasive. With regard to applicant's arguments against recapture on page 15 of their response the fact that a different reference was used to reject the newly presented claims in this reissue application is immaterial. Arguments were made in the parent application to define over the prior art of record, which included the reference to Steiner '713. Further, while applicant cites MPEP 1412.03 that "a claim will be considered a broadening reissue claim when it is grater in scope than each and every claim of the patent to be reissued", this is not the test for recapture. The test for recapture is the three pronged test outlined in the action above as modified now by Pannu.

Regarding applicant's remarks to the rejections the examiner maintains that, as broadly claimed by applicant, the interpretations of the normal and backup sources of hydraulic fluid pressure in the references above is proper. Applicant's have not claimed enough structure, or functional language, for these pressure sources to be as narrowly interpreted as intended by applicants.

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***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Schwartz whose telephone number is 703-308-0576. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cps  
2/2/05

CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER

